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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,767	11/10/2003	Ricardo Perotto	930024-2055	4372
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Ronald R. Santucci Frommer Lawrence & Haug, LLP 745 Fifth Avenue New York, NY 10151			EXAMINER BUTLER, PATRICK NEAL	
			ART UNIT 1791	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/705,767

**Applicant(s)**

PEROTTO, RICARDO

**Examiner**

Patrick Butler

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9's phrase "polyester felt-like material" is not supported by the Specification. However, page 7, lines 18-23, of Applicant's Specification appears to support the term "polyester fabric."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claim 9, the phrase "polyester felt-like material" in line 2 of the claim renders the claim(s) indefinite because the claim includes elements not actually disclosed (those encompassed by "felt-like"), thereby rendering the scope of the claim(s) unascertainable. While felt is made of wool, however a felt-like material, not a true felt, may be made of polyester (see Smith, *Textiles in Perspective*, pages 254, 255,

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and 418; Collier, *Understanding Textiles*, pages 358 and 359). Though it is clear a polyester felt-like material contains polyester, it is unclear what the physical nature of the material would be, and thus the scope of the claim, with respect to the options of non-woven/woven, staple/filament, and smooth/rough with wool's fiber texture that make the polyester have the property of being felt-like. For purposes of examination, the examiner interprets the phrase "polyester felt" to mean any non-woven material having some content of polyester. Page 7, lines 18-23, Applicant's Specification appears to support the term "polyester fabric" which would provide a clear scope of the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 10, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Foffano et al. (US Patent No. 5,995,017).

With respect to Claims 1 and 2, Foffano teaches a method of making a connected sole and upper of a shoe (a method of manufacturing a part of a sports boot) by injection molding (in composite material) with the steps of molding a resting surface of a sole from rubber (preparing a first blank in a flexible material intended to form the external face of the boot part) and an upper (a second flexible material intended to form the internal face of the boot part), wherein the sole 4 (a first flat blank) and upper 2 (a

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second flat blank) are flat with the upper 2 necessarily flat to accommodate the last 13 (see Fig. 1), placing the sole and upper in a mold 11b, 11a with the sole against the impression of the mold 11a, 11b (providing a mold comprising a first half and a second half having a three-dimensional impression of the boot part; placing the first and second blanks on the impression of a first half of a mold with the first blank against the impression) (see claims 1 and 5; col. 2, lines 64-66; and Fig. 4), closing the mold halves 11a, 11b (closing the mold by using its second half) (See Fig. 3-4), injecting polyurethane between the two layers (injecting a foamable binding material between the blanks) (see col. 3, lines 32; claim 5), and removing from the mold after curing of the injected material (mold release after polymerization of the injected material so as to obtain the boot part) (see Fig. 7-12). Foffano teaches that the final shoe is obtained once the last and shell 11a, 11b are removed, providing the shoe with the contour of the mold halves 11a, 11b (comprising the first and second blanks conformed to the three-dimensional impression of the boot part) (see col. 3, lines 35-38 and Fig. 7). Specifically, as a result of the mold's shape, the upper 2 provides the shape required by the foam rather than simply accommodating the last's 13 shape (see Fig. 9). Since Foffano teaches making the sole and upper 2 of the shoe (claim 5 and Figs. 4 and 12), the upper parts and a part of the upper of the boot are made. The upper 2 spans and closes the entire bottom of the shoe (the upper parts comprise two half-shells that cover lateral and medial, respectively, of the wearer's upper foot) (see fig. 11).

With respect to Claim 5, the sole 4 is vulcanized rubber (an elastomer) (see col. 3, line 33).

With respect to Claim 10, Foffano teaches injecting polyurethane between the two layers (see col. 3, lines 32; claim 5).

Claims 3 and 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Foffano et al. (US Patent No. 5,995,017) as evidenced by Smith (*Textiles in Perspective*, page 418).

With respect to Claim 3, the sole 4 is vulcanized rubber (see col. 3, line 33). The rubber is vulcanized, which makes it synthetic. The sole is rubber, which is a polymer, and shaped as a film 4. Therefore, the sole is a polymer film and thus a fabric (see Smith, *Textiles in Perspective*, page 418).

With respect to Claim 4, the sole 4 is vulcanized rubber (elastic) (see col. 3, line 33) and is fabric as described with respect to Claim 3.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Dassler (US Patent No. 4,187,623).

With respect to Claim 6, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach the thickness of the rubber sole.

Dassler teaches making a sports shoe with a rubber sole (first material) with a sole thickness of at the most 1.5 to 1.8 mm (see Dassler, col. 1, lines 34-39), which includes the claimed range of 0.8 - 1 mm (the first material has a thickness of from 0.8 to 1 mm).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Dassler's sole thickness with Foffano's method of making a shoe in order to craft an extremely lightweight athletic shoe (see Dassler, col. 1, lines 34-39).

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Huebner et al. (German Patent Document No. DE 19512499C1).

With respect to Claims 7 and 9, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach the thickness of the rubber sole.

Huebner teaches making a shoe with the upper containing polyester felt (synthetic fabric; polyester felt) at the toe (see abstract and title).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Huebner's polyester felt upper with Foffano's method of making a shoe for the toe cap to be able to retain its air trapping quality under compression at pressures arising during normal use (see Huebner, abstract).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Legassie et al. (US Patent No. 5,343,638).

With respect to Claim 8, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach that the second material comprises elastic fabric.

Legassie teaches using elastic fabric in the upper of a shoe (the second material comprises elastic fabric) (see col. 11, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Legassie's elastic fabric with Foffano's method of making a shoe in order to have an upper that is extremely lightweight and supportively conforms to the contour of the wearer's foot (see Legassie col. 11, lines 35-41).

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Brehmer et al. (US Patent No. 4,793,882).

With respect to Claims 11 and 12, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach that one of the materials has an element affixed to it before it is placed in the injection mold.

Brehmer teaches screen-printing a part of a shoe upper (one of the materials has an element affixed to it before it is placed in the injection mold) (see col. 1, lines 12-19).



It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine screen printing the shoe upper as taught by Brehmer with Foffano's method of making a shoe in order to stiffen the shoe upper (see Brehmer, col. 3, lines 12-14).

Claims 11, 13-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Perotto '130 (US Patent No. 4,428,130).

Foffano teaches a method of making a part of a sports boot as previously described.

With respect to Claims 11, 13, 14, and 17, Foffano does not expressly teach that one of the materials has an element affixed to it before it is placed in the injection mold.

Perotto '130 teaches affixing an eyelet element to a constructed upper before the upper is assembled to form a shoe (one of the materials has an element affixed to it before it is placed in the injection mold; wherein the affixed element is an eyelet for a lace) (see Fig. 1). The eyelet allows threading by hooks or a strap 10. Thus, the eyelet is a reinforcing member in that it provides a way to reinforce the wrapping integrity (a reinforcing element).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine attaching an eyelet 11 as taught by Perotto '130 with Foffano's method of making a shoe in order to have an eyelet to thread a tightening strip 10 through for the top of the item to be tightened (see Fig. 1).

With respect to Claim 14, the eyelet 11 is a ring. The ring could be used as a receiver for a hook. Therefore, it is a ring for gripping, as not step of gripping is positively claimed.

With respect to Claim 15, Foffano does not expressly teach that one of the materials has a watertight flap affixed to it before it is placed in the injection mold.

Perotto '130 teaches a flap 20 that overlies a cutout of the upper. Compared to the cutout, the flap is watertight.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine attaching a flap as taught by Perotto '130 with Foffano's method of making a shoe in order to have a flap to seal the cutout in the upper (see Fig. 1).

Claims 11, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Perotto '319 (US Patent No. 5,050,319).

With respect to Claims 11 and 16, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach that one of the materials has an element affixed to it before it is placed in the injection mold, specifically a protecting tongue.

Perotto teaches attaching a tongue to an inner lining (one of the materials has an element affixed to it before it is placed in the injection mold; wherein the affixed element is a protecting tongue) (see Claim 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Perotto '319's tongue with Foffano's method of making a shoe in order to have a tongue that spread the clamping pressure exerted by the buckles of the boot on the instep and on the anterior part of the bottom of the leg at least to the point that it does not exert painful pressure on the tibia (see Perotto '319 col. 1, lines 14-23 and col. 3, lines 3-17).

With respect to Claim 19, the tongue provides closure on the front of the shoe part. Thus the shoe is a compartment enclosed by the affixed element. This compartment is able to be used to contain the foot or injected personalization material such as bronze for shoe bronzing. As no step of injecting a personalization material is positively claimed and because the shoe is able to fulfill this function as previously described above, the limitations of the claim are met.

### ***Response to Arguments***

Applicant's arguments filed 10 December 2007 have been fully considered but they are not persuasive.

Applicant argues with respect to the 35 USC §112, second paragraph, rejection. Applicant's arguments appear to be on the grounds that:

1) Since polyester felt-like material is implied to be a common term in the art, Claim 9's limitation has been changed to such.

Applicant argues with respect to the 35 USC §102 rejection. Applicant's arguments appear to be on the grounds that:

2) The amended claim language now requires that the upper comprises two half-shells. The blanks relied upon to meet the limitations of the claims include the sole, which would not meet the limitation of being the upper.

Applicant argues with respect to the 35 USC §103 rejection. Applicant's arguments appear to be on the grounds that:

3) Via dependency upon claims that are not anticipated and are non-obvious, Claims 6-9, 11-17, and 19 are also not anticipated and non-obvious since the references do not provide for making the foot upper as claimed.

The Applicant's arguments are addressed as follows:

1) Applicant's arguments with respect to claim 9's term "polyester felt" have been considered but are moot in view of the new ground(s) of rejection.

2 and 3) Foffano's upper 2 spans and closes the entire bottom of the shoe (see fig. 11), thus meeting the limitation that the upper parts comprise two half-shells that cover lateral and medial, respectively, of the wearer's upper foot.

2 and 3) Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the two half shells of the upper are the respective blanks required by the claim) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3) As recited in the rejection above, since Foffano teaches making the sole and upper 2 of the shoe (claim 5 and Figs. 4 and 12), the upper parts and a part of the upper of the boot are made.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. B./

Examiner, Art Unit 1791

/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791